

REMARKS

The applicants respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. No claims have been amended. Claims 1, 3-8, 10-15 and 17-21 have been canceled. Claims 22-38 have been added. Thus, claims 22-38 are pending.

35 U.S.C. §102 Rejections

35 U.S.C. §102 (e) Rejection over Coulson

The Office Action rejects claims 1, 3-8, 10-15 and 17-21 under 35 U.S.C. §102(e) as being anticipated by Coulson, U.S. PG Publication 2003/0074524 A1 (*Coulson*). More particularly, *Coulson* is alleged to disclose, *inter alia*, changing a power state of a hard drive (HD) in response to a predetermined event including at least one of satisfying by a non-volatile cache (NVC) of the HD consecutive HD reads for at least a previous predetermined period of time, and satisfying by the NVC a previous predetermined quantity of consecutive HD reads. Applicants cancel claims 1, 3-8, 10-15 and 17-21 herein in favor of new claims 22-38, rendering the above rejection moot. The new claims are supported in the original disclosure at least by paragraphs [0010], [0018], [0021], [0023] and [0024] of the specification. For at least the following reasons, Applicants submit that each of newly added claims 22-38 is patentable over *Coulson*.

Regarding former claims 1, 3-8, 10-15 and 17-21, the Office Action contends that, under the broadest interpretation, the “predetermined quantity” of read operations disclosed in the

claims **equals** the quantity of read operations that can be serviced by the cache, as disclosed in *Coulson*. The Office Action further alleges that, under the broadest interpretation, the “predetermined period of time” of the claims is disclosed in *Coulson* as being the time it takes for the system to recognize a read request that cannot be serviced by the NVC.

To further distinguish Applicants invention from the cited reference, newly added independent claim 22 states in a salient portion (emphasis added):

“...determining a **threshold number**;
determining a **threshold period of time**;
monitoring a **number of previous consecutive reads** of a hard drive (HD) satisfied by a non-volatile cache (NVC) of the HD;
monitoring a **period of time of previous consecutive HD reads** satisfied by the NVC of the HD;...”

Applicants respectfully submit that the limitations of newly added independent claim 22 **distinguish** (1) a threshold number, (2) a threshold period of time, (3) a number of previous consecutive reads of a HD satisfied by a NVC of the HD, (4) a period of time of previous consecutive HD reads satisfied by the NVC of the HD. Therefore the contention of the Office Action- i.e. that under *Coulson* a “predetermined quantity” of read operations in **always** equal to the quantity of read operations that can be serviced by the cache, and that under *Coulson* a “predetermined period of time” is **identical to** the time it takes for the system to recognize a read

request that cannot be serviced by the NVC- does not speak to the patentability of claim 22, which **distinguishes** these elements, as listed above.

Furthermore, newly added independent claims 25, 28, 31 and 34 include further limitations which variously **distinguish** (5) a threshold quantity of memory space, (6) a quantity of the NVC that would be available to service HD writes when the HD is spun down, (7) a second threshold number, (8) a second threshold period of time and (9) a number of transactions serviced by the NVC or the HD within a previous period of time equal to the second threshold period of time. In variously determining a distinct threshold number, a distinct threshold period of time, a distinct threshold quantity of memory space, a distinct second threshold number and a distinct second threshold period of time, each of newly added independent claims 22, 25, 28, 31 and 34 discloses at least one distinct element which the Office Action argues is **not** distinguished in *Coulson*.

Accordingly, the Office Action by its own reasoning makes the case that each of newly added independent claims 22, 25, 28, 31 and 34 is patentable over *Coulson*. In depending directly or indirectly from one of independent claims 22, 25, 28, 31 and 34, each of claims 23, 24, 26, 27, 29, 30, 32, 33 and 35-38 incorporate at least one element not taught by *Coulson*. Therefore, Applicants submit that each of new claims 22-38 is patentable over *Coulson*.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections of the Office Action are moot. Furthermore, claims 22-38 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

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Respectfully submitted,
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